



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(Case No. 98-385-I)

PATENT

In re Application of: Hauptmann et al. )

Serial No.: 09/898,234 )

Filed: July 3, 2001 )

For: TNF Receptors, TNF Binding )  
Proteins and DNAs Coding For Them )

Before the Examiner: E. O'Hara

Group Art Unit: 1646

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE TO OFFICE ACTION MAILED OCTOBER 4, 2004**

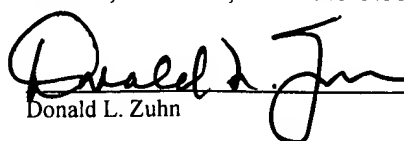
Responsive to the Office Action mailed October 4, 2004, Applicants respectfully request reconsideration of the above-identified application in view of the following remarks. Claims 1, 23, 41, 42, 45-48, and 50-62 are now pending in the instant application.

**1. Provisional rejection of claims 1, 23, 41, 45-48, and 54-62 for double patenting**

The Action asserts a provisional rejection of claims 1, 23, 41, 45-48, and 54-62 under 35 U.S.C. § 101 as claiming the same invention as that of claims 1, 23, 41, 45-48, and 50-59 of copending U.S. Application No. 09/898,429 (the '429 Application). The Action states that the only difference between the claims of the instant application and those of the '429 Application is the recitation, in the latter, of a polypeptide that is not associated with human urinary proteins. The Action also states that because the polypeptide recited in each set of claims is recombinantly produced, neither the polypeptide recited in the instant claims nor the polypeptide recited in the claims of the '429 Application would be associated with urinary proteins. The Action concludes, therefore, that the limitation recited in the claims of the '429 Application has no meaning, and as a result, that the claims of the instant application and those of the '429 Application are identical in

**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, P.O. Box 1450, Alexandria, VA 22313-1450, on February 4, 2005.

  
Donald L. Zuhn

scope.

Applicants note that a provisional rejection based on the statutory type of double patenting can be avoided by either amending the conflicting claims so that they are not coextensive in scope or by canceling the conflicting claims (M.P.E.P. § 804.02). Applicants also note that the claims of the '429 Application have been amended to recite a method for ameliorating the harmful effects of TNF in an animal, comprising administering to an animal in need of such treatment a therapeutically effective amount of a polypeptide comprising the amino acid sequence as set forth in SEQ ID NO: 4, wherein said polypeptide is not associated with human urinary proteins. Applicants contend, therefore, that the claims of the instant application and those of the '429 Application are no longer identical in scope.

## **2. Provisional rejection of claims 1, 23, 41, 42, 45-48, and 50-62 for obviousness-type double patenting**

The Action maintains the rejection of claims 1, 23, 41, 42, 45-48, and 50-62 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 6,417,158 (the '158 Patent). Applicants file herewith a Terminal Disclaimer pursuant to the provisions of 37 C.F.R. § 1.321(c), and respectfully submit that the Disclaimer overcomes the asserted ground of rejection. Withdrawal of this rejection is therefore respectfully solicited.

The Action also maintains the provisional rejection of claims 42 and 51-53 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 42 of the '429 Application. Applicants note that if the Terminal Disclaimer described above is deemed sufficient to overcome the double patenting rejection based on claims 1-44 of the '158 Patent, and the amendments to the claims of the '429 Application are deemed sufficient to overcome the statutory double patenting rejection described in section 1 above, the provisional double patenting rejection based on claim 42 of the '429 Application would be the only remaining rejection asserted against the instant application. Applicants respectfully contend that pursuant to M.P.E.P. § 804, the provisional rejection based on claim 42 of the '429 Application should therefore be withdrawn.

### **CONCLUSIONS**

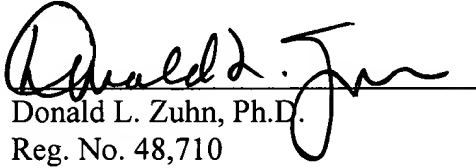
Applicants respectfully contend that all conditions of patentability are met in the pending claims as amended. Allowance of the claims is thereby respectfully solicited.

If Examiner O'Hara believes it to be helpful, she is invited to contact the undersigned representative by telephone at 312-913-0001.

Respectfully submitted,  
**McDonnell Boehnen Hulbert & Berghoff**

Dated: February 4, 2005

By:

  
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